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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DARREL D. CHERRY

Appeal 2008-3062
Application 09/804,607¹
Technology Center 2400

Decided: January 15, 2009

Before JOHN C. MARTIN, LANCE LEONARD BARRY, and
JAY P. LUCAS, *Administrative Patent Judges*.

MARTIN, *Administrative Patent Judge*.

DECISION ON APPEAL
STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 6, 8, 9, 11-16, and 21, which are all of the pending claims, We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

¹ Filed March 12, 2001.

A. Appellant's invention

Appellant's invention relates generally to printing and, in particular, to systems and methods for facilitating remote printing of documents via a printer, which may be communicatively coupled to the Internet, for example. Specification 1:5-7.

B. The claims

The independent claims are claims 11 and 21, which read:

11. A print system for use with an intranet, the intranet being configured to store information corresponding to documents available for printing, said print system comprising:

a document retrieval system communicatively coupled with the intranet, said document retrieval system being configured to receive document reference information corresponding to a document to be printed and printer information corresponding to a network printer that is coupled to the intranet via the Internet and, in response thereto, provide print information corresponding to the document to be printed to the network printer via the Internet such that the network printer prints the document; and

a remote print request system configured to communicatively couple with said document retrieval system, said remote print request system being further configured to retrieve printer information corresponding to the network printer, the printer information including a network address for the network printer, to receive document reference information corresponding to documents available for printing via the intranet, store the document reference information remotely from the intranet, enable selection by a user of a document to be

printed, and provide the printer information and the document reference information corresponding to a document selected to be printed to said document retrieval system such that the document retrieval system communicates the information corresponding to the document to the network printer without further use of the remote print request system.

21. A method for remotely printing a document, said method comprising:

communicatively coupling a personal digital assistant (PDA) to an intranet, the intranet providing access to document reference information corresponding to documents available for printing;

storing the document reference information with the PDA;

retrieving printer information corresponding to a network printer using the PDA, the network printer being configured to communicatively coupled [sic] with the intranet via the Internet, wherein the printer information includes a network address for the network printer; and

communicating, from the PDA, the printer information and the document reference information corresponding to a document to be printed to a document retrieval system located on the intranet such that, responsive thereto, information for printing the document is communicated to the network printer without further use of the PDA, the information for printing the document being communicated from the document retrieval system to the network printer via the intranet and the Internet with the document being printed at the network printer.

(1) Whether Wolff's client 210, on which the Examiner reads the recited "remote print request system" of claim 11, is used (or obviously can be used) "to retrieve" the network address of the desired printer;

(2) Whether claim 11 requires that the recited "document reference information corresponding to documents available for printing" (claim 11) be stored *in* the "remote print request system" (client 210); and

(3) If the answer to Issue 2 is yes, whether Wolff discloses or suggests storing such document reference information in client 210.

ANALYSIS

A. Principles of law

"[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability." *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). A rejection under 35 U.S.C. § 103(a) must be based on the following factual determinations: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) any objective indicia of non-obviousness. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1360 (Fed. Cir. 2006) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966)).

"The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results."

Leapfrog Enter., Inc. v. Fisher-Price, Inc., 485 F.3d 1157, 1161 (Fed. Cir. 2007) (quoting *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1739 (2007)). Discussing the obviousness of claimed combinations of elements of prior art, *KSR* explains:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *Sakraida* [*v. AG Pro, Inc.*, 425 U.S. 273 (1976)] and *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57 (1969)] are illustrative—a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

KSR, 127 S. Ct. at 1740. If the claimed subject matter “involve[s] more than the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement,” *id.*,

it will be necessary . . . to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.

Id. at 1740-41. “To facilitate review, this analysis should be made explicit.” *Id.* at 1741. That is, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.* (quoting *Kahn*, 441 F.3d at 988. *See also PharmaStem Therapeutics Inc. v. ViaCell Inc.*, 491 F.3d 1342, 1360 (Fed. Cir. 2007) (proponent of obviousness based on combination of references must show “that a person of ordinary skill in the art would have had reason to attempt to make the composition or device, or carry out the claimed process, and would have had a reasonable expectation of success in doing so.”) (citations omitted).

A rationale for combining or modifying reference teachings can be based on common knowledge or common sense rather coming from the references themselves. “[T]he [obviousness] analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR*, 127 S. Ct. at 1741.

B. The merits of the rejection of claims 11 and 21

Wolf discloses a printer coupled to and for use with a network providing access to interconnected, on-line documents in response to document requests. Wolf, col. 2, l. 65 to col., 3, l. 1. The printer includes a printer server that handles requests from one or more browser clients and is independent of the one or more browser clients. *Id.*, col. 3, ll. 1-3.

The printer may print a document requested by a user or render a print view image or display a view page on a browser client. *Id.*, col. 4, ll. 65-67. In addition, the printer may arrange and print a compound document from hypertext linked documents that are located within a received document. *Id.*, col. 4, l. 1 to col. 5, l. 3.

Figures 2 and 9 show two different embodiments of Wolf's printer. *Id.*, col. 3, ll. 15-16, 39-40.

Although the Examiner initially based the rejection of claims 11 and 21 on only the Figure 9 embodiment (Final Action 3-5), in the Answer the Examiner principally relies on the Figure 2 embodiment. Answer 4-7.

Figure 2 of Wolf is reproduced below.

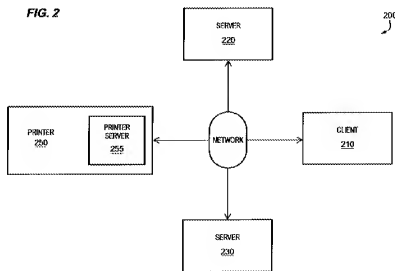


Figure 2 is a block diagram of one embodiment of a printer 250 in a network 200. *Id.*, col. 5, ll. 23-24.

Network 200 also includes client 210 and servers 220 and 230 and, in one embodiment, network 200 comprises the Internet. *Id.*, col., 5, ll. 25-27. However, other embodiments are not limited to retrieving and publishing documents on the “World Wide Web” or the “Internet”; the disclosed teachings may be applied to various networks, data and document storage and archival facilities, or other types of client/server systems that have documents or other information available upon request. *Id.*, col. 5, ll. 27-32.

Client 210 may comprise a program (e.g., a browser) that permits a user to access documents over network 200 that are located on servers 220 and 230. *Id.*, col. 5, ll. 34-36.

If a user requests, via client 210 or otherwise, that an HTML document be printed on printer 250, the user can send a request for the document to printer driver 255 within printer 250. *Id.*, col. 6, ll. 1-4. Printer driver 255 then obtains the document from a server 220 or 230 and renders it as it might appear on printer 250 (or a low-resolution version of the rendering). *Id.*, col. 6, ll. 4-6.

Alternatively, client 210 may transmit a document request directly to server 220 or 230. *Id.*, col. 6, ll. 64-65. Subsequently, server 220 or 230 transmits the document data to printer server 255, where the document handling operations and formatting are implemented. *Id.*, col. 6, l. 65 to col. 7, l. 1. In other embodiments, document handling operations and formatting may be implemented at other servers (e.g., server 220 or 230) prior to being received at printer server 255. *Id.*, col. 7, ll. 1-4. For

example, requests from client 210 may be received at server 220 or 230, wherein all of the document handling and formatting operations are performed prior to transmitting the document data to printer 250 for download. *Id.*, col. 7, ll. 4-8.

Printer server 255 may handle configuration tasks such as having the user select a printer by presenting the user with a network page showing printer locations and including a hypertext map of the printers. *Id.*, col. 6, ll. 28-31.

A user may specify that printer server 255 organize and print compound documents (e.g., a book) received at printer server 255. *Id.*, col. 6, ll. 56-59. A user may select a book format by specifying that documents to be printed should be followed by one or more levels of linked documents. *Id.*, col. 6, ll. 59-61.

Wolff also explains that “[s]erver 255 may be a peripheral including a camera, scanner, facsimile machine, Web Kiosk, storage device, video or audio server, etc.” *Id.*, col. 5, ll. 65-67.

(a) Claim 11

As Appellant does not separately argue the preambular language of claim 11, we will give it no further consideration.

After finding that “Wolff did not explicitly state wherein the client 210 and servers 220 and 230 are coupled via an Intranet” (Answer 4), the Examiner concluded that such a modification would have been obvious because Wolff’s “disclose[s] that the network as used in the present invention is not just limited [to] the Internet but the teachings may be applied to ‘various networks’ (Wolf, col. 5, lines 25-33).” *Id.* Appellant does not deny that it would have been obvious to modify Wolff so as to satisfy the recited “intranet” and “Internet” limitations.

The Examiner (Answer 5-6) reads claim 11 on the embodiment in which client 210 (the recited “remote print request system”) sends a document printing request to one of servers 220 and 230 (the recited “document retrieval system”), which in turn sends the requested document information to printer 250 (the recited “network printer”). Wolff, col. 6, l. 64 to col. 7, l. 1. Appellant denies that client 210 performs all of the functions required of the remote print request system. The first function argued by Appellant is the requirement that the remote print request system be “configured to retrieve printer information corresponding to the network printer, the printer information including a network address for the network printer.”² The Examiner, initially addressing the embodiment in which client 210 communicates directly with printer 250, found that “[at] col. 6,

² Being “configured” to perform a function means being capable of performing that function.

lines 55-60, Wolff disclosed the client having the ability to communicate with the printer, which would require the client to contain the network address of the printer, otherwise, it would not be able to communicate with the printer.” Answer 6. Then, addressing the embodiment in which client 210 sends the print request to server 220 or 230, the Examiner found that “[at] col. 6, lines 64-67, Wolff disclosed the client having the ability to communicate through server 220 or 230 to transmit document printing request, which, as explained above, would require the printer information to be communicated along with the request in order for the server to interpret the request.” Answer 7. Appellant, addressing the embodiment in which client 210 sends the print request directly to printer 250, argues that

the fact that Wolff's client (210) can communicate with the printer does not mean that the client (210) is capable of retrieving printer information that includes a printer's network address. Wolff mentions nothing of how the client becomes aware of an address for communicating [with] printer (250). Based on Wolff's teachings, one can only presume that the network address of the printer (250) is provided to the client (210).

Reply Br. 4. This argument is unpersuasive. Appellant's assertion that Wolff mentions nothing of how the client becomes aware of an address for communicating with printer 250 apparently fails to take into account Wolf's above-noted disclosure that printer server 255 may have the user select a printer by presenting the user with a network page showing printer locations and including a hypertext map of the printers. Wolff, col. 6, ll. 28-31.

Selection of a printer at a particular location will necessarily involve identifying that printer's network address. Appellant's assertion that Wolff's system is not "capable of retrieving printer information that includes a printer's network address" (Reply Br. 4) is unconvincing because the term "retrieve" is not defined in Appellant's Specification and therefore must be given its broadest reasonable interpretation, *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997), and Appellant has not demonstrated that the broadest reasonable definition precludes that term from being read on Wolff. To the contrary, the term "retrieve" as used in Appellant's Specification appears to be broad enough to include even the technique of manually entering the printer's network address into the remote print request system:

In block 506, retrieval of network printer information is facilitated. For instance, network printer information may be obtained by communicatively coupling the PDA and, in particular, the remote print request system, with the printer that is to facilitate printing of the selected document(s). Communicative coupling may be accomplished with various methodologies, including, for example, infrared communication, physically coupling the PDA to a port of the printer, Ethernet, the Internet, etc. *In other embodiments, network printer information required to facilitate the desired printing may be directly provided to the remote print request system, such as by the user manually inputting the IP address of the printer into the PDA.* Other network printer information that may be utilized may include model number, print options, and printer capabilities, among others.

Specification 13:10-19 (emphasis added).

For the foregoing reasons, we are also unpersuaded by the similar arguments Appellant directs at the embodiment on which the rejection is based, in which client 210 sends the print request to server 220 or 230 rather than to printer 250. Regarding that embodiment, Appellant argues:

Wolff does NOT disclose that the client (210) has the ability to communicate through server 220 or 230 to transmit document printing request. Instead, Wolff, col. 6, lines 64-67 plainly states that the client (210) may transmit print requests directly to (not through) a server (220 or 230). As discussed above that server (220 or 230) then transmits the document, formatted or not, to the printer (250). Wolff mentions nothing of how the server (220 or 230) becomes aware of an address for communicating printer (250). Based on Wolff's teachings, one can only presume that the network address of the printer (250) is manually provided.

Reply Br. 5. We understand the last sentence in the above-quoted paragraph to mean that the network address of the printer is manually provided to server 220 or 230.

Although Wolff does not specifically describe using client 210 to obtain the printer's network address and send it to server 220 or 230, which then sends the requested document information to that printer, we agree with the Examiner's analysis that such is necessarily the case. Answer 7. Client 210 is the only means through which the user can designate the desired printer. Furthermore, for the reasons given above the "retrieve" language appears to be broad enough to read on any manner of entering the printer's network address into client 210, including manual entry. Alternatively, in

view of Wolff's above-quoted discussion (column 6, lines 28-31) of using client 210 to select the desired printer from a list of available network printers provided to client 210 by a printer server to permit when client 210 sends print requests directly to the printer, it would have been obvious to permit client 210 to select the desired printer in a similar manner when client 210 sends print requests to the printer via servers 220 or 230.

As explained below, Appellant further argues that Wolff fails to disclose or suggest using the remote print request system to store document reference information corresponding to documents available for printing, as called for in the "receive" and "store" limitations in the following claim language:

a remote print request system configured . . . to *receive* document reference information corresponding to documents available for printing via the intranet, *store* the document reference information remotely from the intranet, *enable* selection by a user of a document to be printed, and *provide* the printer information and the document reference information corresponding to a document selected to be printed to said document retrieval system such that

Claim 11 (emphasis added).

The Examiner, addressing the "receive" and "enable" requirements, explained that "[at] col. 6, lines 55-64, Wolff disclosed the user may specify that the printer server organize and print compound documents, by allowing the user to specify documents to be printed in a specific order, i.e. levels of linked documents." Answer 6-7. Regarding the "store" requirement, the

Examiner explained that “[at] col. 5, lines 65-67, Wolff disclosed that the print server may be used as storage, therefore storing the documents for reference.” Answer 7. Discussing the “provide” limitation, the Examiner explained that “[at] col. 6, lines 64-67, Wolff disclosed the client having the ability to communicate through server 220 or 230 to transmit document printing request, which, as explained above, would require the printer information to be communicated along with the request in order for the server to interpret the request.” Answer 7.

Appellant does not deny that client 210 is capable of *receiving* (e.g., for viewing) document reference information corresponding to documents available for printing via the intranet. Instead, Appellant argues that client 210 does not *store* document reference information corresponding to documents available for printing via the intranet:

Claim 11 recites that the remote print request system (not the printer) is configured to receive and store document reference information remotely from the intranet. That document reference information corresponds to documents available for printing. The fact that Wolff’s print server can be used for storage is irrelevant. Wolff makes no mention or suggestion that the client (210) stores document reference information corresponding to documents available for printing.

Reply Br. 4.³

³ Appellant does not separately argue the “remotely from the intranet” language.

We agree that the “document reference information” that the claim specifies is stored remotely from the intranet corresponds to documents available for printing. The Examiner did not hold otherwise. However, we do not agree with Appellant’s assertion that “[t]he fact that Wolff’s print server can be used for storage is irrelevant.” *Id.* Although the claim requires that the remote print request system be configured to *receive* document reference information that corresponds to documents available for printing, it does not require that such information be *stored* in the remote print request system. Instead, the claim language is broad enough to permit the document reference information to be stored, under the control of the remote print request system, in a location other than the remote print request system, provided that the other location is remote from the intranet. Appellant does not deny that Wolff’s printer server when implemented as a storage device constitutes such a location.

Furthermore, assuming for the sake of argument that claim 11 requires storage of document reference information corresponding to documents available for printing *in* the remote print request system, Appellant has not explained why that limitation is not satisfied by client 210. As noted above, client 210 may comprise a browser that permits a user to access documents over network 200 that are located on servers 220 and 230. *Id.*, col. 5, ll. 34-36. While the browser in client 210 is being used to display a list of the documents available on server 220 or 230, client 210 will inherently be storing data that is being used to generate the displayed list of documents.

Alternatively, Appellant has not explained why the Examiner erred in finding that the “store” limitation is satisfied when client 210 is being used to organize and print compound documents by allowing the user to specify documents to be printed in a specific order. Wolff, col. 6, ll. 54-61. When used for that purpose, client 210 will (or obviously can) store document reference information identifying the selected documents until at least such time as client 210 sends the print request to server 220 or 230. Appellant has not explained why the claimed “documents available for printing” cannot be read on the compound documents that have been selected for printing.

The rejection of claim 11 is therefore affirmed.

(b) Claim 21

Regarding the rejection of claim 21, Appellant repeats the arguments made regarding the rejection of claim 11, which have been answered above.

The rejection of claim 21 is therefore affirmed.

C. The rejection of dependent claims 6, 12, 13, 15, and 16

The rejection of dependent claims 6, 12, 13, 15, and 16 for obviousness over Wolff is affirmed because Appellant has not separately argued the merits of those claims. 37 C.F.R. § 41.37(c)(1)(vii) (2006).

D. The rejection of dependent claims 8, 9, and 14

The rejection of dependent claims 8, 9, and 14 for obviousness over Wolff in view of Jaynes is affirmed because Appellant has not separately argued that rejection with respect to either of those claims, with the result that those claims fall with independent claims 11 and 21. *In re Nielson*, 816 F.2d 1567, 1572 (Fed. Cir. 1987).

DECISION

The rejection of claims 6 and 11-13, 15, 16, and 21 under 35 U.S.C. § 103(a) for obviousness over Wolff is affirmed, as is the § 103(a) rejection of claims 8, 9, and 14 for obviousness over Wolff in view of Jaynes.

The Examiner's decision that claims 6, 8, 9, 11-16, and 21 are unpatentable for obviousness over the prior art is therefore affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. §§ 41.50(f) and 41.52(b).

AFFIRMED

Appeal 2008-3062
Application 09/804,607

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